

REMARKS

The Applicant appreciates the Examiner's careful examination of this case. Reconsideration and re-examination are respectfully requested in view of the instant remarks.

With regard to paragraph 1 of the Office Action, claims 3 and 5 - 7 have been made dependent upon claim 1 in order to meet the objection raised by the Examiner. Claims 8 and 9 appeared to be correct. Claim 10 was made dependent on claim 1.

With regard to paragraphs 2 and 3 of the Office Action, claim 1 has been amended to specify that the activated carbon has substantially its entire surface available for contact with the oil. Swanson is such that the activated particulate carbon would not have substantially its entire surface available for contact with the oil because much of the activated particulate carbon in Swanson would be buried in the support paper.

With regard to paragraph 4 of the Office action, the Applicant relies for patentability of claims 3, 5, 6, 8 and 18 on the fact that these claims include all of the features of the amended claim 1, which claim 1 is believed to be allowable for reasons stated above, and also for reasons stated below.

With regard to paragraph 5 of the Office Action, it is noted that Brownawell discloses a filter as stated by the Examiner. The Brownawell disclosure is however such that there is only one layer of the non-active filter material 12. The Applicant has accordingly amended claim 1 to specify that the retainer material is

in the form of a plurality of radially extending adjacent layers (see the Applicant's Figure 1) or pieces (see the Applicant's Figure 8) with the activated carbon between the layers or pieces wherein the activated carbon extends radially to a depth defined by the layers or pieces. In Brownawell, the activated carbon does not have the Applicant's radial depth. The radial depth is advantageous in that there is much more active carbon available with the Applicant's construction for giving a much better removal of the mutagens.

In addition, claim 1 has been amended to specify that the Applicant's retainer material is a water-absorbent material. The Brownawell non-active filter material 12 will almost surely in practice be corrugated cardboard. The corrugated cardboard will have to be treated with a water resisting material in order to make the corrugated cardboard not water absorbent. If the corrugated cardboard were to be water absorbent, it would very quickly become soggy and would collapse. The Brownawell active carbon would then also just collapse because the Brownawell active carbon needs the Brownawell corrugated cardboard 12 to stay in place. Thus, making the Applicant's retainer material of a water absorbing material, is yet another difference over Brownawell.

With regard to paragraph 6 of the Office Action, the Applicant relies for the patentability of claims 3, 5, 6 and 8 on the fact that these claims include all of the features of the amended claim 1, which amended claim 1 is believed to be allowable for the reasons stated above.

With regard to paragraph 7 of the Office Action, the Examiner has rejected claims 1, 7, 9, 10 – 14 and 16 – 18 as being anticipated by Bauer (US 3,836,005) or Giampalmi Jr. (US 3,730,347). Bauer uses granular carbon and not activated particulate carbon. The Bauer filter cartridge is for use with a dry cleaning solvent. The Bauer filter is clearly not for filtering engine oil. Bauer does not show the Applicant's retainer material in the form of a plurality of radial extending adjacent layers or pieces with the activated carbon between the layers or pieces. Giampalmi also discloses a filter which is for use in dry cleaning. Giampalmi refers to charcoal and not the Applicant's particulate activated carbon.

Giampalmi relates to holding a packed bed of charcoal firmly in place under a compressive force. The Giampalmi filter is clearly not of the same construction as now specified in the Applicant's amended claim 1.

In paragraph 8 of the Office Action, the Examiner has rejected claim 3 as unpatentable over Bauer or Giampalmi. The Applicant relies for patentability of claim 3 on the fact that claim 3 includes all of the features of the Applicant's presently amended claim 1, and claim 1 is believed to be allowable for the reasons stated above.

In paragraph 9 of the Office Action, the Examiner rejects claims 19 and 20 as unpatentable over Swanson or Brownawell in view of Semar. The Applicant's claim 1 is shown above to be patentable over Swanson or Brownawell. Thus the Applicant relies for patentability of claims 19 and 20 on the fact that these claims include all of the features of claim 1, claim 1 is patentable over Swanson or

Brownawell, and the disclosure in Semar does not affect the patentability of claim 1.

In paragraph 10 of the Office Action, the Applicant has rejected claim 21 as unpatentable over Swanson, Bauer or Giampalmi in view of Brownawell. The Applicant has demonstrated above that the amended claim 1 is allowable over Swanson, Bauer and Giampalmi. Thus the Applicant relies for patentability of claim 21 on the fact that this claim includes all of the features of claim 1. The disclosure in Brownawell does not affect the allowability of claim 1 as stated above.

With regard to paragraph 11 of the Office Action, the Applicant was obliged to the Examiner for pointing out the relevance of the Swanson disclosure. Claim 1 has been further amended to distinguish over Swanson as stated above.

The Applicant has dealt above with the new ground(s) of rejection as set out in paragraph 12 of the Office Action.

Accordingly, it is respectfully submitted that this application is in condition for allowance. Early and favorable action is respectfully requested.

If for any reason this **RESPONSE** is found to be **INCOMPLETE**, or if at any time it appears that a **TELEPHONE CONFERENCE** with Counsel would help advance prosecution, please telephone the undersigned or one of his associates, collect in Waltham, Massachusetts, at (781) 890-5678.

Respectfully submitted,

T. Thoms
Thomas E. Thompson, Jr.
Reg. No. 47,136